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EXAMINER

TOMASZEWSKI, MICHAEL

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3626

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/044,357 | <b>Applicant(s)</b><br>PROVOST ET AL. |  |
|                              | <b>Examiner</b><br>Mike Tomaszewski  | <b>Art Unit</b><br>3626               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/11/2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____                                                            | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Notice To Applicant*

1. This communication is in response to the amendment filed on 7/3/2006. Claims 1, 9, 14, and 21-23 have been amended. Claims 1-25 remain pending.

### *Specification*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The specification is objected to under 35 U.S.C. § 112, first paragraph, because the specification, as originally filed, does not provide support for the invention as is now claimed for the reasons in section 4, *infra*.

4. The amendment filed 5/2/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "accessing a database

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having data indicative of supporting documents associated with insurance claims that are received from the client system," "identifying a supporting document needed to process the insurance claim from the database based on the insurance claim received from the client system," "receiving an access request from the carrier for the electronic image of the supporting document," "accessing a supporting document database having a compilation of data indicative of supporting documents associated with insurance claims generated by the client system," "identifying a specified supporting document needed to process the insurance claim using the supporting document database," "generating a list of supporting documents needed to process the insurance claim based on the insurance claim, the list of supporting documents identified from a supporting document database having data indicative of supporting documents required for insurance claims submitted by a client system of the health care provider," "providing the list of supporting documents to the client system," "identified in the list of supporting documents." Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

5. Claims 1-33 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

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application was filed, had possession of the claimed invention and for the reasons set forth in the objection to the specification in section 4, *supra*.

Claims 1, 12, 14, and 21 recite limitations that are new matter, as discussed above. Claims 2-13, 15-20, and 22-26 incorporate the deficiencies of claims 1, 12, 14, and 21 through dependency and are also rejected.

*Applicant is advised to provide support for all features added to the amendment filed on 5/2/2006.*

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**NOTE:** The following rejections assume that the subject matter added in the amendment filed on 7/3/2006 is not new matter and are provided hereinbelow for Applicant's consideration on the condition that Applicant properly traverses the new matter objections and rejections set forth in sections 2-5, *supra*, in the next communication sent in response to the present Office Action.

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7. Claims 1-2, 5-10, 12-13, 21-22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (6,283,761; hereinafter Joao), in view of Peterson et al. (6,343,271; hereinafter Peterson), as applied in the previous Office Action and incorporated herein, and further in view of Applicant's prior art admissions in the background of the invention of the present application (10/044,347) and Official Notice.

(A) As per currently amended claim 1, Joao discloses in a server system that communicates with a client system associated with a physician and is adapted to facilitate processing of an insurance claim, a method of delivering a supporting document to a carrier to enable the carrier to process an insurance claim, the method comprising the acts of:

- (1) receiving an insurance claim from the client system (Joao: abstract; col. 2, line 25-col. 3, line 45; col. 4, line 59-col. 5, line 7; fig. 1);
- (2) accessing a database having data indicative of supporting documents associated with insurance claims that are received from the client system (Joao: col. 4, lines 5-11; col. 5, lines 7-18; col. 6, lines 45-61; col. 34, lines 59-62);
- (3) receiving an electronic image of the supporting document associated with the insurance claim in an electronic format from the client system (Joao: col. 2, line 25-col. 3, line 45; col. 4, line 59-col. 5, line 7);

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- (4) storing an electronic image of the supporting document (Joao: col. 35, line 65-col. 36, line 5); and
- (5) notifying the carrier that the electronic image is available via a web server associated with the server system (Joao: col. 4, lines 5-11; col. 5, lines 7-18; col. 6, lines 45-61; col. 34, lines 59-62); and
- (6) receiving the electronic image of the supporting document (Joao: col. 2, line 25-col. 3, line 45; col. 4, line 59-col. 5, line 7 and lines 60-59).

Joao, however, fails to *expressly* disclose in a server system that communicates with a client system associated with a physician and is adapted to facilitate processing of an insurance claim, a method of delivering a supporting document to a carrier to enable the carrier to process an insurance claim, the method comprising the acts of:

- (7) receiving an access request from the carrier for the document (emphasis added.); and
- (8) identifying a supporting document needed to process the insurance claim from the database based on the insurance claim received from the client system.

Nevertheless, these features are old and well known in the art, as evidenced by Peterson, Applicant's prior art admissions. In particular, Peterson, Applicant's prior art admissions, and Official Notice disclose in a server system that communicates with a

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client system associated with a physician and is adapted to facilitate processing of an insurance claim, a method of delivering a supporting document to a carrier to enable the carrier to process an insurance claim, the method comprising the acts of:

- (7) receiving an access request from the carrier for the document (Official Notice) (Examiner takes Official Notice that the techniques of receiving access requests for documents are notoriously well known within the IT arts and were widely used at the time of Applicant's invention. For example, third parties (e.g., insurers) that are interested in accessing documents of other parties (e.g., patients) must request access first, especially when dealing with highly sensitive/confidential documents, such as medical records.); and
- (8) identifying a supporting document needed to process the insurance claim from the database based on the insurance claim received from the client system (Peterson: abstract; col. 3, lines 19-30) (Examiner notes that Peterson teaches a claim processing system "that would more easily allow health care providers to know (i.e. identify) what patient and treatment information (i.e., supporting documents) must accompany insurance claims.).

Examiner also notes Applicant's prior art admissions within the background of the present application. For example, Applicant makes the following admissions:

“... requiring numerous supporting documents to accompany a health care insurance claim. These supporting documents, such as laboratory reports, X-rays, physician notes, patient charts, discharge papers, etc. are typically needed before processing of the health care insurance claim can occur.”

“delivering hardcopies of the supporting documents...”

“health care provider often receives a request for the supporting documents..”

“To enable the carrier or payer to process the insurance claim, an employee of the healthcare provider must collect the needed documents, obtain hardcopies of the documents, and mail the copies to the carrier.”

“Adjudicating a claim...may require multiple submissions of the same claim, with or without associated supporting documents.”

As such, Examiner acknowledges the following to be well known and obvious:

- Supporting documents relating to health care insurance claims;
- Receiving requests for and providing supporting documents;
- Collecting/Identifying needed supporting documents;

(Examiner notes that before a carrier can determine if a claim is missing supporting documents and other information (i.e., the claim is incomplete), the carrier must first identify (i.e., generate a list) what supporting documents and other information is required. In other words, one cannot determine a claim is incomplete without knowing what needs to be included to begin with (i.e., identifying and generating a list of the supporting document(s) to be submitted).

- Transmitting/Receiving supporting documents; and

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Peterson and Applicant's prior art admissions with the teachings of Joao and the techniques of receiving access requests for documents with the motivation of avoiding claim processing delays resulting from claim submissions with too little information (Peterson: col. 3, lines 23-30).

One of ordinary skill would have found it obvious at the time of the invention to combine the techniques of receiving access requests for documents with the combined teachings of Joao, Peterson and Applicant's prior art admissions with the motivation of controlling access to sensitive/confidential information.

(B) As per original claim 2, Joao discloses a method as recited in claim 1, further comprising the act of transmitting information to the client system that causes the client system to prompt a user of the client system to submit the supporting document associated with an insurance claim (Joao: col. 25, lines 15-19; col. 29, lines 28-40; col. 35, lines 11-col. 36, line 30; fig. 1).

(C) As per original claim 5, Joao discloses a method as recited in claim 1, further comprising the acts of:

- (1) transmitting claim information associated with the insurance claim to a

payment entity, wherein, upon receiving the claim information, the payment entity advances money to the client system prior to the carrier making payment on the insurance claim (Joao: col. 37, lines 48-65; fig. 1); and

- (2) transmitting the insurance claim to the carrier, wherein, upon receiving the insurance claim, the carrier makes payment on the insurance claim to the payment entity, thereby paying for the money advanced to the client system (Joao: col. 37, lines 48-65; fig. 1).

(D) As per original claim 6, Joao discloses a method as recited in claim 1, wherein the act of notifying the carrier comprises the act of delivering an access credential to the carrier, the access credential being patient specific (Joao: col. 4, lines 6-10; col. 7, lines 16-24; col. 39, lines 54-62).

(E) As per original claim 7, Joao discloses a method as recited in claim 6, wherein the access credential is unique to the carrier (Joao: col. 4, lines 6-10; col. 7, lines 16-24; col. 39, lines 54-62).

(F) As per original claim 8, Joao discloses a method as recited in claim 1, further comprising the act of, upon receiving a request from the carrier, transmitting the electronic image of the supporting document to the carrier (Joao: col. 4, lines 5-11; col.

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5, lines 7-18; col. 6, lines 45-61; col. 34, lines 59-62; col. 31, line 65-col. 32, line 46; fig. 1).

(G) As per currently amended claim 9, Joao discloses a method as recited in claim 1, wherein identifying a supporting document further comprising the act of transmitting a request for the supporting document to the client system, wherein the supporting document is received by the server system in response to the request (Joao: col. 4, lines 5-11; col. 5, lines 7-18; col. 6, lines 45-61; col. 34, lines 59-62; col. 31, line 65-col. 32, line 46; fig. 1).

(H) As per original claim 10, Joao discloses a method as recited in claim 9, further comprising the act of selecting the supporting document based on information included in the insurance claim, wherein the act of requesting the supporting document is performed after and in response to the act of selecting the supporting document (Joao: col. 4, lines 5-11 and lines 26-33; col. 5, lines 7-18; col. 6, lines 45-61; col. 34, lines 59-62; col. 31, line 65-col. 32, line 46; fig. 1).

(I) As per original claim 12, Joao discloses a method as recited in claim 1, further comprising, prior to transmitting the insurance claim to the carrier, determining whether the insurance claim is in condition for payment (Joao: col. 3, lines 33-45; col. 6, lines 1-3; col. 7, lines 43-48).

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(J) As per original claim 13, Joao discloses a method as recited in claim 12, wherein it is determined that the insurance claim is not in condition for payment, the method further comprising the acts of:

- (1) prior to transmitting the insurance claim to the carrier, notifying the client system that the insurance claim is not in condition for payment (Joao: col. 4, lines 5-11; col. 5, lines 7-18; col. 6, lines 1-4 and 45-61; col. 34, lines 59-62; fig. 1-2); and
- (2) receiving an amended insurance claim from the client system in which one or more errors in the insurance claim have been corrected, such that the amended insurance claim is in condition for payment (Joao: col. 4, lines 5-11; col. 5, lines 7-18; col. 6, lines 1-4 and 45-61; col. 19, lines 31-39; col. 34, lines 59-62; fig. 1-2).

(K) As per currently amended claim 21, Joao discloses in a server system that communicates with a client system associated with a health care provider and is adapted to facilitate processing of an insurance claim, a method of delivering a supporting document to a carrier to enable the carrier to process an insurance claim and for advancing payment to the physician, the method comprising the acts of:

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- (1) determining that an insurance claim for services rendered by the health care provider is in condition for payment (Joao: col. 3, lines 33-45; col. 6, lines 1-3; col. 7, lines 43-48); and
- (2) transmitting claim information associated with the insurance claim to a payment entity, such that the payment entity can advance money to the health care provider prior to the carrier making payment on the insurance claim (Joao: col. 37, lines 48-65; fig. 1);
- (3) generating supporting documents needed to process the insurance claim based on the insurance claim, the supporting documents identified from a supporting document database having data indicative of supporting documents required for insurance claims submitted by a client system of the health care provider (Joao: col. 4, lines 5-11; col. 5, lines 7-18; col. 6, lines 45-61; col. 34, lines 59-62);
- (4) providing the supporting documents to the client system (Joao: col. 4, lines 5-11; col. 5, lines 7-18; col. 6, lines 45-61; col. 34, lines 59-62);
- (5) upon receiving the supporting documents associated with the insurance claim in an electronic format from the client system, storing electronic image of the supporting documents (Joao: col. 2, line 25-col. 3, line 45; col. 4, line 59-col. 5, line 7; col. 35, line 65-col. 36, line 5); and
- (6) transmitting the insurance claim and a notice indicative of the availability of the electronic image to the carrier, such that the carrier can access the image, process the insurance claim, and make payment on the insurance

claim to the payment entity, thereby paying for the advance payment previously made to the health care provider (Joao: col. 4, lines 5-11; col. 5, lines 7-18; col. 6, lines 45-61; col. 34, lines 59-62).

Joao, however, fails to *expressly* disclose in a server system that communicates with a client system associated with a health care provider and is adapted to facilitate processing of an insurance claim, a method of delivering a supporting document to a carrier to enable the carrier to process an insurance claim and for advancing payment to the physician, the method comprising the acts of:

- (7) generating a list of supporting documents; and
- (8) providing the list of supporting documents.

Nevertheless, these features are old and well known in the art, as evidenced by Applicant's prior art admissions and Official Notice. In particular, Applicant's prior art admissions, and Official Notice disclose in a server system that communicates with a client system associated with a health care provider and is adapted to facilitate processing of an insurance claim, a method of delivering a supporting document to a carrier to enable the carrier to process an insurance claim and for advancing payment to the physician, the method comprising the acts of:

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- (7) generating a list of supporting documents (Applicant's prior art admissions as discussed in claim 1 above); and
- (8) providing the list of supporting documents (Applicant's prior art admissions as discussed in claim 1 above).

Examiner also takes Official Notice that the techniques of generating lists of requirements (e.g., documents needed) and providing the same lists are notoriously well known within the healthcare and insurance arts and were widely used at the time of Applicant's invention. For example, as admitted by Applicant, carriers and payers collect and identify needed supporting documents (i.e., generate a list) so that claims can be adjudicated.

One of ordinary skill would have found it obvious at the time of the invention to combine Applicant's prior art admissions and the techniques of generating lists of requirements and providing the same lists with the combined teachings of Joao and Peterson with the motivation of facilitating claim adjudication.

(L) Currently amended claims 22 and original claim 24 substantially repeat the same limitations of claims 1-20 and are therefore, rejected for the same reasons given for those claims and incorporated herein.

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8. Claims 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao, in view of Peterson, in view of Applicant's prior art admissions, and Official Notice, as applied in claim 1 above and incorporated herein, and further in view of Robinson-Crowley, Christine ("Understanding Patient Financial Services" Copyright 1998. Aspen Publishers; hereinafter Robinson).

(A) As per original claim 3, Joao discloses a method as recited in claim 1, further comprising the act of determining whether the insurance claim is eligible for payment (Joao: col. 5, line 60-col. 6, line 5).

Joao, however, fails to *expressly* disclose a method as recited in claim 1, further comprising an *advance* payment [emphasis added].

Nevertheless, this feature is old and well known in the art, as evidenced by Robinson. In particular, Robinson discloses a method as recited in claim 1, further comprising an advance payment (Robinson: pg. 144; Examiner considers repayment to read on "advance payment.").

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Robinson with the combined teachings of Joao, Peterson, Applicant's prior art admissions, and the techniques of receiving access requests for documents with the motivation of facilitating insurance claim processing (Joao: col. 2, lines 45-55).

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(B) As per original claim 11, Joao discloses a method as recited in claim 9, further comprising the act of notifying the client system that the insurance claim is eligible for payment, wherein the act of notifying is conducted prior to the act of transmitting the request for the supporting document (Joao: col. 4, lines 5-11; col. 5, lines 7-18; col. 6, lines 45-61; col. 34, lines 59-62; col. 31, line 65-col. 32, line 46; fig. 1).

Joao, however, fails to *expressly* disclose a method as recited in claim 1, further comprising an *advance* payment [emphasis added].

Nevertheless, this feature is old and well known in the art, as evidenced by Robinson. In particular, Robinson discloses a method as recited in claim 1, further comprising an advance payment (Robinson: pg. 144; Examiner considers repayment to read on "advance payment.").

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Robinson with the combined teachings of Joao, Peterson, Applicant's prior art admissions, and the techniques of receiving access requests for documents with the motivation of facilitating insurance claim processing (Joao: col. 2, lines 45-55).

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao, Peterson, Applicant's prior art admissions, Official Notice, and Robinson as applied to claim 3 above, and further in view of Doyle, Jr. et al. (5,070,452; hereinafter Doyle).

(A) As per claim 4, Joao fails to *expressly* disclose a method as recited in claim 3, wherein the act of determining whether the insurance claim is eligible for advance payment comprises:

- (1) determining whether the treatment information corresponds to health care services that are approved for payment; and
- (2) determining whether the patient is an approved beneficiary of the carrier.

Nevertheless, these features are old and well known in the art, as evidenced by Doyle. In particular, Doyle discloses a method as recited in claim 3, wherein the act of determining whether the insurance claim is eligible for advance payment comprises:

- (1) determining whether the treatment information corresponds to health care services that are approved for payment (Doyle: abstract; col. 3, lines 5-10; fig. 1); and
- (2) determining whether the patient is an approved beneficiary of the carrier (Doyle: abstract; col. 3, lines 5-10; fig. 1).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Doyle with the combined teachings of Joao, Peterson, Applicant's prior art admissions, Official Notice, Robinson and the techniques of

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receiving access requests for documents with the motivation of providing an improved system for the administration of medical insurance claims (Doyle: col. 1, lines 65-67).

10. Claims 14-17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao and in view of Peterson, as applied in the previous Office Action and incorporated herein, and further in view of Applicant's prior art admissions in the background of the invention of the present application (10/044,347).

(A) As per claim 14, Joao discloses in a client system that is associated with a physician and communicates with a server system adapted to facilitate processing of an insurance claim, a method of providing a supporting document to the server system to enable a carrier associated with the insurance claim to process an insurance claim, the method comprising the acts of:

- (1) displaying an insurance claim form on the client system (Joao: abstract; col. 4, lines 11-26; fig. 1);
- (2) receiving, at the client system associated with the institutional health care provider, user input representing patient information, insurance information, and treatment information (Joao: abstract; col. 2, line 25-col. 4, line 5; col. 4, line 59-col. 5, line 7; col. 16, lines 38-65; fig. 1);

- (3) transmitting an insurance claim that includes the patient information, insurance information, and treatment information from the client system to the remote server computer (Joao: abstract; col. 2, line 25-col. 25-col. 4, line 5; col. 4, line 59-col. 5, line 7; fig. 1);
- (4) accessing a supporting document database having a compilation of data indicative of supporting documents associated with insurance claims generated by the client system (Joao: col. 4, lines 5-11; col. 5, lines 7-18; col. 6, lines 45-61; col. 34, lines 59-62);
- (5) transmitting the supporting document in the electronic format from the client system (Joao: col. 25, lines 15-19; col. 29, lines 28-40; col. 35, lines 11-col. 36, line 30; fig. 1).

Joao, however, fails to *expressly* disclose in a client system that is associated with a physician and communicates with a server system adapted to facilitate processing of an insurance claim, a method of providing a supporting document to the server system to enable a carrier associated with the insurance claim to process an insurance claim, the method comprising the acts of:

- (6) identifying a specified supporting document needed to process the insurance claim using the supporting document database; and

- (7) prompting a user of the client system to provide a specified supporting document in an electronic format, wherein the specified supporting document is required to process the insurance claim.

Nevertheless, these features are old and well known in the art, as evidenced by Peterson, Applicant's prior art admissions, and Official Notice. In particular, Peterson and Applicant's prior art admissions (as set forth in claim 1 above) disclose in a client system that is associated with a physician and communicates with a server system adapted to facilitate processing of an insurance claim, a method of providing a supporting document to the server system to enable a carrier associated with the insurance claim to process an insurance claim, the method comprising the acts of:

- (6) identifying a specified supporting document needed to process the insurance claim using the supporting document database (Peterson: abstract; col. 3, lines 19-30) (Examiner notes that Peterson teaches a claim processing system "that would more easily allow health care providers to know (i.e. identify) what patient and treatment information (i.e., supporting documents) must accompany insurance claims.); and
- (7) prompting a user of the client system to provide a specified supporting document in an electronic format, wherein the specified supporting document is required to process the insurance claim (Peterson: abstract; col. 3, line 12-col. 4, line 20; fig. 1-11).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Peterson and Applicant's prior art admissions with the teachings of Joao with the motivation of providing a means for facilitating claim processing (Peterson: col. 3, lines 54-63).

(B) As per original claim 15, Joao fails to *expressly* disclose a method as recited in claim 14, further comprising the act of identifying the specified supporting document.

Nevertheless, this feature is old and well known in the art, as evidenced by Peterson. In particular, Peterson discloses a method as recited in claim 14, further comprising the act of identifying the specified supporting document (Peterson: abstract; col. 3, line 12-col. 4, line 20; fig. 1-11).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Peterson with the teachings of Joao with the motivation of providing a means for facilitating claim processing (Peterson: col. 3, lines 54-63).

(C) As per original claim 16, Joao discloses a method as recited in claim 15, wherein the act of identifying the specified supporting document comprises the act of receiving a request for the supporting document from the server system (Joao: col. 25, lines 15-19; col. 29, lines 28-40; col. 35, lines 11-col. 36, line 30; fig. 1).

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(D) As per original claim 17, Joao discloses a method as recited in claim 14, further comprising the act of receiving data from a scanner associated with the client system, wherein the data from the scanner represents the supporting document in the electronic format and is received in response to a paper copy of the document being scanned by the scanner (Joao: col. 16, lines 3-18; col. 25, lines 15-19; col. 29, lines 28-40; col. 35, lines 11-col. 36, line 30; fig. 1).

(E) As per original claim 19, Joao discloses a method as recited in claim 14, wherein the act of transmitting the supporting document is conducted such that the carrier can process the insurance claim without any supporting documents being sent by mail (Joao: abstract; col. 3, line 33-col. 4, line 25; col. 6, lines 45-52; fig. 1).

(F) As per original claim 20, Joao discloses a method as recited in claim 19, wherein the act of transmitting the supporting document is conducted such that the server system is capable of making an electronic image of the supporting document available to the carrier (Joao: abstract; col. 3, line 33-col. 4, line 25; col. 6, lines 45-52; fig. 1).

11. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao and in view of Peterson, in view of Applicant's prior art admissions in the background of the invention of the present application (10/044,347), and further in view of Robinson.

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(A) As per claim 18, Joao discloses a method as recited in claim 14, further comprising the act of receiving notification from the server system that the insurance claim is eligible for advance payment (Joao: col. 5, lines 7-18; col. 5, line 60-col. 6, line 5, fig. 1).

Joao, however, fails to *expressly* disclose a method as recited in claim 1, further comprising an *advance* payment [emphasis added].

Nevertheless, this feature is old and well known in the art, as evidenced by Robinson. In particular, Robinson discloses a method as recited in claim 1, further comprising an advance payment (Robinson: pg. 144; Examiner considers repayment to read on "advance payment.").

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Robinson with the combined teachings of Joao, Peterson and Applicant's prior art admissions with the motivation of facilitating insurance claim processing (Joao: col. 2, lines 45-55).

12. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao, Peterson, Applicant's prior art admissions, and Official Notice, as applied to claim 21 above, and further in view of Doyle.

(A) Currently amended claim 23 substantially repeats the same limitations of claim 4 and therefore, is rejected for the same reasons given for those claims and incorporated herein.

13. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao, Peterson, Applicant's prior art admissions, and Official Notice, as applied to claim 21 above, and further in view of Howes (6,738,784; hereinafter Howes).

(A) As per original claim 25, Joao fails to *expressly* disclose a method as recited in claim 24, further comprising the act of transmitting a suggested revised treatment code that corresponds to the health care services rendered to the client system.

Nevertheless, this feature is old and well known in the art, as evidenced by Howes. In particular, Howes discloses a method as recited in claim 24, further comprising the act of transmitting a suggested revised treatment code that corresponds to the health care services rendered to the client system (Howes: col. 10, lines 45-51; col. 11, lines 24-33).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Howes with the combined teachings of Joao, Peterson, Applicant's prior art admissions and the techniques of receiving access requests for documents with the motivation of improved medical document processing (Howes: col. 2, lines 40-44).

***Response to Arguments***

14. Applicant's arguments filed 7/3/06 with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

15. Applicant's arguments filed 7/3/06 have been fully considered but they are not persuasive. Applicant's arguments have been addressed hereinbelow in the order in which they appear in the response filed 7/3/06.

(A) On pages 9-10 of the 7/3/06 response, Applicant argues that the cited references do not establish a prima facie case of obviousness. Applicant notes that the Office Action alleges that Joao teaches:

- (1) receiving an insurance claim from the client system;
- (2) storing an electronic image of the supporting document; and
- (3) notifying the carrier that the electronic image is available via a web server associated with the server system so as to enable the carrier to access the electronic image and process the insurance claim.

Applicant, however, points out that, at the same time the Office Action notes that Joao fails to expressly disclose:

- (4) receiving a supporting document associated with the insurance claim in an electronic format from the client system.

Applicant argues further that if Joao fails to teach receiving a supporting document (4), then it cannot teach storing an electronic image of the supporting document (2).

In response, Examiner notes that Examiner initially interpreted the Joao reference to, in fact, teach a portion of the claimed feature, that is, "receiving a supporting document." But having considered the claimed limitation as a whole, Examiner did not interpret the Joao reference to *expressly* teach a supporting document "associated with the insurance claim" *per se*. Upon further consideration, Examiner respectfully submits that Examiner had interpreted the Joao reference too narrowly.

Nevertheless, Applicant's arguments are moot in view of the new grounds of rejection necessitated by amendment.

(B) On pages 10-11 of the 7/3/06 response, Applicant argues Joao fails to teach or suggest the requirement of claim 1, namely, notifying the carrier that the electronic image is available.

In response, Examiner respectfully submits that Joao does teach and suggest the aforementioned limitation.

First, Joao teaches the use of electronic commerce technologies in information processing and transmission. Examiner considers this to encompass the well known

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use of technologies such as the web, Internet, web servers, server systems, electronic images, and also associated techniques such as electronic file transfer, electronic imaging/digitizing, electronic image transfer, and the like (Joao: col. 4, lines 5-11).

Second, Joao teaches that his invention can be utilized to transmit and/or receive *notification messages* pertaining to a wide variety of healthcare information (e.g., claims, payments, supporting documents, such as X-rays, etc.) between various parties (e.g., carriers, payers, patients, etc.) (Joao: col. 5, lines 7-18).

Third, Joao teaches that his invention can be utilized to process healthcare claims, to *notify* any party (e.g., carrier, payer, etc.) regarding any event, happening, occurrence (e.g., availability of supporting documents), and/or any aspect of any claim submission and/or processing activities (Joao: col. 6, lines 45-61).

Fourth, Joao teaches the storing of a enormous array of healthcare information including *medical video, image, X-rays, MRI files, CAT scans, ad infinitum*, all of which Examiner considers to be electronic images of supporting documents as defined by Applicant in the background of the instant application (Joao: col. 16, line 66-col. 17, line 12). Moreover, Joao teaches that his system can be coupled to a scanner to input and/or enter (i.e., digitize/create electronic images) healthcare information (e.g., supporting documents) (Joao: col. 16, lines 4-18).

In short, Examiner respectfully disagrees with Applicant and submits that Joao does indeed teach and suggest the aforementioned limitation.

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(C) On pages 11-12 of the 7/3/06 response, Applicant argues that claims 14 and 21, for at least the same reasons Applicant proffered in section 15. (A) and (B) above, overcome the prior art.

As such, Examiner respectfully submits that Examiner's responses in section 15. (A) and (B) above fully address the arguments pertaining to claim 14 and 21.

### ***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MT



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